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Paper No. 13  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re BTIO Educational Products, Inc., by change of name  
from Baby Think It Over, Inc.<sup>1</sup>

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Serial No. 75/712,224

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Michael S. Sherrill of Sherrill Law Offices for BTIO  
Educational Products, Inc., by change of name from Baby  
Think It Over, Inc.

Florentina Blandu, Trademark Examining Attorney, Law Office  
112 (Janice O'Lear, Managing Attorney).

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Before Simms, **Chapman** and Rogers, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant filed, on May 17, 1999, an application to  
register the mark SOME DECISIONS LAST A LIFETIME on the  
Principal Register for "educational dolls and printed  
instructional materials for use with the dolls, all sold as  
a unit" in International Class 28. Applicant bases its

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<sup>1</sup> Applicant's change of name was recorded with the Assignment  
Branch of this Office in January 2001 at Reel 2219, Frame 0195.

application on Section 1(a) of the Trademark Act, claiming a date of first use in commerce of August 14, 1996.<sup>2</sup>

Registration has been finally refused in the application because applicant has failed to submit specimens acceptable to the Examining Attorney. Specifically, the Examining Attorney asserts that the specimens submitted by applicant do not show use of the mark on or in connection with the identified goods as required by Trademark Rule 2.56.<sup>3</sup>

Applicant has appealed, and briefs have been filed. Applicant did not request an oral hearing.

The specimens submitted by applicant are photocopies of the front page and the back page of applicant's February 1999 catalog, the mark SOME DECISIONS LAST A LIFETIME

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<sup>2</sup> The application also included services, specifically, "providing information in the fields of infant care simulation programs and pregnancy deterrence by means of a global computer network" in International Class 42. Registration was initially refused for both classes based on the Examining Attorney's requirement for acceptable specimens. However, the Examining Attorney withdrew the refusal as to the International Class 42 services. Applicant then filed a request to divide out that class and Serial No. 75/980,029 was created for International Class 42. (Serial No. 75/980,029 was published for opposition on March 27, 2001.)

<sup>3</sup> In her brief on the case the Examining Attorney cited Trademark Rule 2.58 and TMEP §1301.04, both of which refer to specimens of use for service marks. Moreover, Trademark Rule 2.58 was removed and reserved by Final Rule notice appearing in the September 28, 1999 Official Gazette, with an effective date of October 30, 1999. The relevant provision of the Trademark Rules of Practice is found in Trademark Rule 2.56. (The Examining Attorney had cited Trademark Rule 2.56 and TMEP §905 in the first Office action.)

appears on the back page. A photocopy of applicant's specimen is reproduced below (in reduced form):

Applicant has not submitted any substitute specimens.

However, with its brief on appeal, applicant submitted a photocopy of its entire February 1999 catalog, stating that it was "to provide complete information in this case" and "to assist the Board's understanding of the case." (Brief, p. 4). The Examining Attorney objected to the

additional evidence submitted with applicant's brief, and she requested that the evidence be excluded.

The record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal will be given no consideration by the Board. See Trademark Rule 2.142(d), and TBMP §1207.01. Inasmuch as the additional material was filed after the appeal, and the Examining Attorney objected thereto, applicant's additional evidence is untimely pursuant to Trademark Rule 2.142(d). Accordingly, the catalog (other than the front and back pages which were previously made of record) attached to applicant's appeal brief does not form part of the record on appeal and has not been considered in making our decision.<sup>4</sup>

Turning to the merits of the appeal, the sole issue before us is whether the specimens submitted with the application are acceptable specimens of use of the mark SOME DECISIONS LAST A LIFETIME for the goods set forth in the application.

The dissent disagrees with our statement of the issue on appeal, and construes the issue as whether applicant's

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<sup>4</sup> To the extent applicant's purpose in filing the complete catalog was to prove that its specimen truly is the back cover of its catalog, the submission was not necessary, as the Examining Attorney has not disputed this point.

slogan functions as, or would be perceived as, a mark, not whether the specimens are acceptable proof of trademark use. We note, however, that the Examining Attorney and applicant discuss sufficiency of specimen cases at length, not cases dealing with the question whether a slogan would be perceived as a mark. Moreover, we note that the Examining Attorney accepted the specimens in the file for applicant's services but refused those for applicant's goods. If, as the dissent argues, the Examining Attorney's position is that applicant's slogan does not function as a mark, the specimens for the services would not have been accepted, for they present the slogan in a virtually identical display as the specimens for the goods. The dissent urges that we presume a certain correctness of Examining Attorney decision-making. In fact, we do exactly that by considering only the basis for refusal the Examining Attorney has chosen to articulate.<sup>5</sup>

Applicant contends that pursuant to the case of Lands' End Inc. v. Manbeck, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992), and TMEP §905.06(a), the Examining Attorney should accept as a proper specimen any catalog (a display

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<sup>5</sup> Likewise, we have acknowledged the correctness of the Examining Attorney's argument for exclusion of applicant's catalog as the subject of an untimely proffer. The dissent, without pointing to any error in the Examining Attorney's position, nonetheless freely considers this untimely evidence.

associated with the goods), provided that it includes (i) a picture of the goods, (ii) the mark sufficiently near the picture of the goods to associate the mark with the goods, and (iii) information necessary to order the goods.

Applicant concludes that applying this criteria, the back page of its catalog is an acceptable specimen.

While agreeing with applicant's statement of the law in the Lands' End case, the Examining Attorney disagrees that applicant's specimens meet those requirements. Specifically, the Examining Attorney contends that applicant's use of its mark "appears to be a slogan that the applicant is using in advertisements and not as wording to identify the goods in question (the doll)" (Final Office action, p. 2); that the specimen does not clearly indicate that applicant offers dolls for sale under the mark SOME DECISIONS LAST A LIFETIME, but rather the manner of use of the applied-for mark is that "of a slogan and the doll appears as a visual aid intended to give greater weight to the slogan in question" (brief, p. 4); that there is much verbiage appearing on the page, all of it in close proximity to the slogan SOME DECISIONS LAST A LIFETIME; and that consumers will not perceive the wording SOME DECISIONS LAST A LIFETIME as a source indicator for dolls. Further, while the specimens include a telephone number for ordering

the goods, the Examining Attorney finds the lack of information on the cost of the doll<sup>6</sup>, or the page number where specific information on the pictured goods could be found inside the catalog unacceptable. In conclusion, the Examining Attorney finds this situation more analogous to the case of *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997) (wherein asserted "fact sheet" brochures or "catalog pages" were found to be mere advertising and unacceptable specimens).

We emphasize that, despite references in the file which might suggest otherwise, the Examining Attorney has not refused registration on the basis that the applied-for mark fails to function as a trademark under the **Trademark Act**.<sup>7</sup> Rather, the sole issue before us on appeal is whether the specimens submitted with the application are acceptable under the Court's decision **in** Lands' End interpreting the **Trademark Act**, as applicant contends, or are unacceptable advertising as in the Board's decision in the MediaShare case. Cf., for example, *In re Walker-Home Petroleum, Inc.*, 229 USPQ 773 (TTAB 1985).

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<sup>6</sup> In fact, the specimen clearly indicates that at least one model of applicant's dolls is available at a "special" price of \$199. It is unclear whether the pictured model is the particular model available at this price.

<sup>7</sup> Thus, we do not wonder, as does the dissent, about whether applicant's slogan, or other slogans, could properly be refused registration as failing to function as marks.

Section 1 of the Trademark Act, as well as Trademark Rule 2.56, require that prior to registration applicant submit a specimen showing the mark as used on or in connection with the goods in commerce. Trademark Rule 2.56(a) reads as follows:

An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen showing the mark as used on or in connection with the goods, or in the sale of advertising of the services in commerce.

Following the 1992 decision of the United States District Court for the Eastern District of Virginia in the Lands' End case, supra, the USPTO revised the section of the Trademark Manual of Examining Procedure (TMEP) dealing with catalogs as specimens. TMEP §905.06(a) reads, in relevant part, as follows:<sup>8</sup>

In accordance with this [the Lands' End] decision, examining attorneys should accept any catalog or similar specimen as a display associated with the goods, provided that (1) it includes a picture of the relevant goods, (2) it includes the mark sufficiently near the picture of the goods to associate the mark with the goods, and (3) it includes information

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<sup>8</sup> The Court specifically stated "[t]he question for determination here is whether Lands' End's use of the term 'KETCH' in the manner described above in its retail catalog constitutes a use of 'displays associated' with the goods satisfying the use in commerce provision in 15 U.S.C. §1127," and the Court found that it did.



necessary to order the goods. Any form of advertising which satisfies these criteria should be construed as a display associated with the goods.

We agree with applicant that the last page from its catalog showing the mark SOME DECISIONS LAST A LIFETIME meets the criteria set forth above. The specimen clearly pictures a doll being held by a teenage boy. We believe the purchasing public would certainly notice the doll, and there is no requirement in the Lands' End case or the TMEP that the specimen must picture every separate doll offered for sale. That is, even if applicant offers several different types or models of dolls, each separate one need not be pictured in order for the specimen to be an acceptable display associated with the goods.<sup>9</sup>

The mark appears sufficiently near the pictured doll to associate the mark with the goods. The Examining Attorney acknowledges in her brief (p. 4) that the specimens would be acceptable if the question were the proximity of the marks BABY THINK IT OVER and/or GENERATION 4 for dolls. The applied for mark SOME DECISIONS LAST A

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<sup>9</sup> We do not, as the dissent implies, countenance registration under Lands' End of a mark for widely varying goods appearing anywhere in a catalog. Rather, we simply acknowledge that an item in a catalog may be available in different colors or sizes or with slight variations not significant enough to utilize a photograph of every variation, when these differences can be noted in the catalog's description of the goods.

LIFETIME appears in very large type on the left side of the page approximately one inch from the doll's head, whereas, GENERATION 4 appears in smaller type approximately 2 inches from the doll's head. Applicant has achieved sufficient proximity of the mark and the picture of the goods for the purchasing public to associate the mark with the goods.

The specimen clearly includes a telephone number for ordering applicant's products. The Examining Attorney's concern that the specimen sets forth the cost of only one model of the doll, and does not set forth the page number inside the catalog where the specific models and associated price information may be found is simply not required by the **Trademark Act** or the Lands' End case.

We readily acknowledge that the facts of this case are not precisely the same as those in the Lands' End case. For example, in the Court case, the catalog displayed several different goods per page, each with a picture and a description of the item, whereas in the case now before us, applicant's mark is depicted on the back page with only one featured item for sale appearing on the same page. However, as explained earlier herein, the only refusal before this Board is based on the requirement for acceptable specimens, not an assertion that the applied-for mark fails to function as a trademark, as used on the

specimen. If our decision is an extension of the Lands' End decision at all, it is not a dramatic extension, but rather is a slight extension which is clearly in keeping with the spirit of the Lands' End case, and the policy stated in the TMEP regarding catalog pages as specimens for goods. See *In re Hydron Technologies Inc.*, 51 USPQ2d 1531 (TTAB 1999).

The MediaShare case, where applicant's goods were identified as "computer software for publishing information on a computer network and instructional manuals therefor, sold together as a unit," and the specimens were held to be mere advertising material is distinguishable from the case now before us. For example, in that case applicant's "fact sheet" showed three computer screen displays, yet the Board found none of these "appears to constitute or include a picture of applicant's 'PB.WEB' computer software, whether in use or otherwise." MediaShare, supra at 1306. Thus, the specimens in that case failed to meet the second requirement of the Lands' End case.

To the extent we have any doubt on the question of whether applicant's use of the mark SOME DECISIONS LAST A LIFETIME on the back page of its catalog constitutes an acceptable display associated with the goods, we resolve that doubt in favor of applicant.

**Decision:** The refusal to register based on a requirement for acceptable specimens is reversed.

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Simms, Administrative Trademark Judge, dissenting:

Because I agree with the Examining Attorney that applicant has not demonstrated trademark use of the slogan sought to be registered and that customers will not view applicant's slogan as a means of identifying and distinguishing the source of applicant's dolls, I would affirm the requirement for specimens which show use of the asserted mark as a trademark.

A copy of the last page of applicant's mail-order catalog is reproduced on page 3 of the majority's opinion. For illustrative purposes, other pages, beginning with the front page of applicant's catalog, are reproduced (in reduced form) below.

Ser. No. 75/712224

I believe the *Lands' End* case cited by the majority is distinguishable. In that case, the obvious trademark KETCH appeared with a picture of a purse along with a description of the goods. The court concluded the consumers can associate the product with the mark in applicant's mail-order catalog, and that the catalog could be considered a display associated with the goods. The mark KETCH and the description of the goods, the court noted, also distinguished that product shown in the catalog from others shown in the catalog. That case should not be read as holding that any word or slogan prominently used with a picture of the goods and ordering information is acceptable trademark use such that the catalog always acts as a display associated with those goods. *Lands' End* should not be mechanistically applied to permit registration as a mark of such an informational slogan merely because such slogan is prominently displayed next to a picture of the goods with ordering information.

While the Examining Attorney acknowledges that catalogs used as displays associated with the goods may be acceptable specimens showing trademark use, in this case the Examining Attorney has refused registration because the specimens of record do not show use of the asserted mark in connection with applicant's educational dolls. It is the

Examining Attorney's position that the manner in which the specimens show the asserted mark to be used is simply as a slogan used in promoting applicant's goods and not as a trademark for applicant's dolls. In other words, the question here is not whether these specimens would be acceptable if applicant were using a mark to identify and distinguish its goods from those of others. The Examining Attorney does not contend that applicant's mail-order catalogs would be unacceptable if applicant were in fact using a mark to identify and distinguish its goods, as in the *Lands' End* case. The majority parses the Examining Attorney's refusal here to state that the Examining Attorney is not arguing that the slogan presented for registration does not function as a mark. However, I believe that is precisely what the Examining Attorney is saying. The Examining Attorney states that the asserted mark is merely a slogan that applicant is using in its catalog and is not wording which identifies and distinguishes applicant's dolls. See Final Refusal, 2. The Examining Attorney contends, in my view correctly, that consumers will not perceive the slogan as a trademark for applicant's dolls. It is difficult for me to believe that consumers would perceive the informational or promotional phrase "Some decisions last a lifetime" on the last page of

applicant's mail-order catalog as a trademark identifying and distinguishing applicant's dolls, especially in view of the use of applicant's obvious trademark BABY THINK IT OVER and its trade name on the same page. *Cf.*, for example, *Hoover Co. v. Royal Appliance Mfg. Co.*, \_\_\_ F.3d \_\_\_, 57 USPQ2d 1720 (Fed. Cir. 2001)(slogan used in close proximity to party's principal trademark not likely to be perceived as a trademark). One wonders if the majority would reach the same decision it does here if, instead of the asserted mark SOME DECISIONS LAST A LIFETIME, applicant instead were using simply the statement "ORDER THIS DOLL TODAY."

Under the guise of the *Lands' End* case, the majority here sanctions the registration of a slogan which is not used as a trademark. Applicant's slogan is not obviously a trademark but is more in the nature of an informational or advertising phrase. While shown in relatively close proximity to one of applicant's dolls, this slogan is on the last page of applicant's mail-order catalog and is, significantly, used nowhere else in the catalog. In addition, as shown above, other slogans of a similar nature are used on other pages in the catalog. Therefore, I agree with the Examining Attorney that consumers would not



perceive the slogan shown on only one page of applicant's catalog as a mark for the doll pictured on that page.<sup>10</sup>

Finally, the majority, citing no authority, states that on the issue of acceptable specimens, doubt should be resolved in favor of applicant. It is to be noted that the court in the *Lands' End* case indicated that the issue of whether displays associated with the goods are acceptable as trademark use is a factual question. Where questions of fact have been presented, the Board has on occasion entertained a presumption of correctness of an Examining Attorney's judgment. See, for example, *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984)(whether matter presented for registration functioned as a mark was a question of fact concerning which the judgment of the Examining Attorney is entitled to a presumption of correctness); and *In re Keyes Fiber Company*, 217 USPQ 730, 734 (TTAB 1983)(where the asserted mark consisted of

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<sup>10</sup> Without authority, the majority states that applicant's specimens need not picture every doll offered for sale under its asserted mark. Aside from the fact that this issue does not appear to be raised by the arguments of the attorneys, this statement would appear to be at odds with *Lands' End*, which held that the catalog presented a display associated with the goods by the use of the mark KETCH next to a picture and the description of the goods. The court did not state or imply that this mark functioned as a trademark for other goods not pictured near the mark. In fact, the clear implication is to the contrary, the court stating that the mark KETCH helped distinguish the product next to which it was pictured from others.

subject matter not ordinarily perceived as a trademark, the Examining Attorney's evaluation that it was not entitled to registration was a presumption which had to be overcome by persuasive evidence to the contrary) and cases cited therein.

We should only register slogans that perform the function of a mark, and not pretend that other informational or promotional slogans function as marks when they are used prominently with the goods with which they are sought to be registered. I would affirm the refusal that the specimens do not show use of the slogan as a mark for dolls.